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10/014,191	11/13/2001	Christoph Dobrusskin	PHN 16,257A	4074

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EXAMINER	
HYLINSKI, STEVEN J	
ART UNIT	PAPER NUMBER
3714	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/014,191	DOBRUSSKIN ET AL.	
	Examiner	Art Unit	
	STEVEN J. HYLINSKI	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 February 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *4-6,12 and 16-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4-6,12 and 16-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 02/24/2010 have been fully considered but they are not persuasive. Despite the amended limitations raising additional new matter issues, as discussed below, Harris already discusses saving and retrieving data either locally on the screen-based device, or remotely (See Col. 20 Lines 55-67). As pointed out by Examiner, because the control of a remote device from Harris' screen-based user device is carried out through data transactions, a user's command will be at least temporarily stored as a data signal, in order for Harris' computer system to be functional (Fig. 10 "receive control data" from the peer device). Therefore, the system taught by Harris in view of Baker, in which the icons No. 311 can be animated in response to user input as per Baker's teaching, will be animating the icon based on actions of the user (physical user input) and the stored information of the last user interaction (control data signal transmitted to the controlled device based on the physical user input).

2. Applicants' arguments on pages 10 and 11 regarding the difference between the instant invention, and the capability of Harris in view of Baker to store data, exceeds the scope of the claims. The independent claims now include storing and updating stored information (which as Examiner has pointed out would be necessary for any data transaction), but do not claim doing so for the purpose of saving a discontinued session, and then resuming this discontinued session at a later time.

3. Examiner respectfully disagrees with Applicant's allegations that there is "no practical improvement" when the icons of Harris are animated using the well-known

teaching of Baker, and that Examiner was making mere conclusory statements to support an obviousness finding. Examiner clearly articulated one of the rationales to support a 35 U.S.C. 103 rejection under *KSR* - that combining prior art elements according to known methods would yield predictable results (see MPEP 2141 Section III part (A). There need not be an explicit teaching in the prior art references to support such a conclusion of obviousness. The examiner recognizes that obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves **or in the knowledge generally available to one of ordinary skill in the art.** See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, any artisan of skill would recognize that static icons on a computer screen could be improved by animating them in response to user inputs. Applicant has not proven that one of skill in the art would have not been able to combine the known methods (e.g. due to technical difficulties) or that doing so would produce any unexpected results. Applicant's own specification and claims admit that making icons movable "facilitates interaction with the service field".

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 4-6, 12, and 16-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Re Claims 4 and 16,

The limitation reading "the icon being movable within the service field based on actions by the user to facilitate interaction with the service field including information of a last user interaction related to the service field" of claim 4, and the similar limitation in lines 14-16 of Claim 16 beginning "varying location of the icon", is not fully supported by the specification. The only relevant passages of the specification that discuss a user being able to discontinue or freeze a session that can be resumed at a later time, read as follows:

> "The evoking of a specific icon on the host screen is token for an allowable interactivity, and the storing of appropriate processing results in the item allows a user to discontinue a session, whilst still being able to later resume at an interaction point that is deemed relevant." (page 2 lines 12-16) and "If the item has been removed, in block 72 the service field is closed, the content of the permanent memory of the item is being frozen for later use, and the iconized display of the actual item is suppressed." (Page 4 lines 12-14).

The lack of enablement lies in the fact that the independent claims state that movement of the *icon* facilitates the inclusion of information of a user's last interaction with the service field (Claim 4 Lines 8-12, Claim 16 Lines 14-16) whereas the

specification as quoted above, only appears to support that physical movement of the actual *item*, drives saving the state of the item such that the service field can be resurrected at a later time. There is no support for movement of the icon itself, facilitating the service field including information of a last user interaction.

Re Claims 16 and 26,

The limitation in lines 5-8 of claim 16 and 4-7 of claim 26, regarding receiving information from the item at the host including stored information of a last user interaction, is also new matter because it is not enabled by the specification. The passages of the specification regarding saving and restoring, referenced above, do not specifically state that the device stores and transmits the stored state back to the user, to resume a previously-terminated session, they simply acknowledge that a save/restore feature exists.

Re Claims 21 and 27,

The specification further does not specifically support stored information of a last user interaction, being identified by the application program.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 26-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and

transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal *per se,* the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter. *See In re Nuitjen,* 500 F.3d 1346, 1356-57 (Fed. Cir. 2007)(transitory embodiments are not directed to statutory subject matter).

A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C.§101 by adding the limitation "non-transitory" to the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 4-6, 12, and 16-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,331,972 to Harris et al. (Harris), in view of US 5,715,416 to Baker.

Re Claims 4, 12, 16, 23, 25-26, 28, and 30,

8. **Harris discloses a multimedia method and computer program for use with a screen-based host system** (Col. 6 Lines 11-54, Harris discloses a peer-to-peer system, which by definition means that each node, which can be a PDA, cell phone, PC,

etc, and hence-screen based, functions as both a client and server or host at the same time, without the need for a central server.) **provided with information processing and I/O facilities** (Fig. 2 shows exemplary hardware included in a peer device, which includes processor **40** and optional I/O devices **46**), **and for interacting with an item, the method comprising:**

receiving identity information from the item at the host including stored information of a last user interaction related to the identity information (Fig. 6, block **82** shows that the two peer to peer devices evaluate their needs vs. capabilities. Figs. 8 and 9 give examples of needs and capabilities that each device can have, which include information that identify the device. Any data signal inherently meets the limitation of being stored for some period of time. Col. 8 Lines 6-20 state that data specific to the user and also application data generated by performing peer applications, is stored in the memory **42** of a peer device. Col.20 Lines 55-67 further state that memory in each device can store, place, and retrieve data, either locally on the user's device or remotely on another device.)

in response to proximity conditions between the host and the item (Col. 6 Lines 31-35), **presenting to a user an icon that is representative of the item** (Harris states in Col. 19 Lines 49-58 that the icon of Fig. 20 is "a suitable icon **311**" that is accompanied by command text for a particular command. As discussed in the argument section above, the icons **311** that are functionally tied to the VCR of Fig. 20, would obviously be recognizable by one of skill in the art, as representing video reels. Video reels can reasonably be interpreted as representing a video cassette recorder machine

due to their common theme. Even if, for the sake of argument, the icons **311** were not recognizable as video reels that could be associated with the VCR device, which Examiner is not conceding, MPEP § 2144.04 states that aesthetic and change-in-shape differences over the prior art fail to render an invention patentable. Furthermore, the visual appearance of a graphical user interface icon can be rejected as a design choice consideration, as discussed above) **and associated service field at the host in response to the identity information** (Col. 12 Lines 62-67 and Col. 13 Lines 1-5, if the two devices are in range of each other and their capabilities and needs are compatible, a program is transferred from one device to the other and a user interface is automatically loaded to allow the user of one device to access the other device. Fig. 20 shows an example of a user's device **300** that has had a program loaded on it to control another device. The graphical user interface shown on display **309** is clearly a service field.),

and transmitting information from the application program to the item based on the interaction including an update to the stored information of the last user interaction, for storage at the item (Each device has memory **42** as shown in Fig. 2, which must at least temporarily store data received from the other device. Col. 12 Lines 15-67 states that user input capabilities are provided through I/O and directed to a service-receiving peer (remote device or appliance). The user input is collected (the "last user interaction" is whatever I/O the user most recently performed which was then collected as data) and then the collected user input data is sent to the service-receiving peer device (remote device), which is then used to control the peer. The data

representing any of the user's I/O is stored information because data that exists for any length of time is inherently being stored as a signal. Furthermore, Harris discusses saving and retrieving data either locally on the screen-based device, or remotely (See Col. 20 Lines 55-67).

selecting an icon that is representative of the item (Fig. 20, arrow **312** indicates the user's selection of one of the icons **311.** See the rejection of claim 4 above, in which it is discussed that the icons can be interpreted as video reels that one of skill in the art would associate with the VCR device, and alternatively, that changes in shape and aesthetic changes do not render an invention patentable over the prior art per MPEP 2144.04) **and application program based on the identity information, the application program including one of an information processing program and an entertainment program** (Col. 12 Lines 62-67 and Col. 13 Lines 1-5, if the two devices are in range of each other and their capabilities and needs are compatible, a program is transferred from one device to the other and a user interface is automatically loaded to allow the user of one device to access the other device, hence the program is an information processing program), executing the application program at the host system (Fig. 10 **112**)

However, Harris lacks the icons varying location within a service field of the application based on actions of a user to facilitate interaction with the application program, the icons being user-definable, and being animated.

Baker is an analogous prior art reference in the art of graphical user interfaces, that proves it is very old and well-known in the art to allow users of a graphical user

interface to create their own user-definable icons for use in the graphical user interface, (See Columns 3 and 9) and also that icons can be animated with animations unique to the icon (Column 9 Lines 38-67). Animating icons according to the method of Baker, also meets the limitation of **the icon varying location based on the actions of the user, to facilitate the user's interaction with the service field including an interaction point related to the service field and the user interaction** (Col. 9 Lines 34-65 describes how icons have icon-specific animations. As discussed above in the arguments, Examiner is interpreting that at the time the user's electronic device is allowed to connect to another device (**102**) and take control of the device (**116**), interaction points are reached. Interaction point **116** provides the service field. Baker further provides evidence that the shape of the icon, such as that used by Harris as discussed above, is a design choice consideration in the art. Baker states that it is known for each icon in an operating system, to be associated with a structure that contains information that associates operating system file objects with the icon, and also pictorial information with the icon. Col. 22 shows that it is known for the data structure describing the icon, to contain information labeled "*icon.image", which specifies what image is associated with the icon.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art, that incorporating Baker's old and well-known teaching of user definable and animated icons being used to improve a graphical user interface having icons associated with commands, into Harris' compatible and ready-for-improvement invention, would cause the same results of animated icons providing feedback to the

user regarding the tasks the user performs on the icons, devoid of any new or unexpected consequences.

Re Claims 5, 21, and 27,

As discussed in the rejection of the independent claims above, each user input through I/O is gathered as data that is then sent over a connection from the user device to a controlled peer device, and each historically-logged action through I/O is an inherently stored "last user interaction". The I/O means allows the user to activate information processing operations in the system (see Col. 12 Lines 15-67).

Re Claim 6,

Harris discloses transmitting host-generated results related to the associated service field during such proximity conditions to the item (Fig. 20 shows the exemplary embodiment of host **300** being able to send commands to one or more VCR's. These commands, input by the user using the interface on the PDA, constitute host-generated results.)

Re Claims 22, 24 and 29,

Examiner discusses above how one of skill in the art would recognize the icons **311** associated with VCR commands, as video reels intended to establish their functional relationship to the VCR device. Even if this fact is argued, MPEP 2144.04 states that aesthetic design changes and changes in shape fail to render an invention patentable over the prior art. Changing the visual identity of an icon constitutes both an aesthetic design change and a change in shape. Furthermore, in view of Baker's teaching that it is old and well-known in the art that the images associated with icons in

graphical user interfaces can be readily changed, it would have been further obvious to one of ordinary skill in the art, at the time the invention was made, that changing the visual identity of an icon in a graphical user interface already including 2D icons, would produce merely predictable results.

Re Claims 17 and 31,

In Col. 12 Lines 62-67 and Col. 13 Lines 1-5, Harris discloses that one of the peer devices loads an application program from the other, and then presents the user's device with a user interface based on the program. Harris shows providing an iconized representation of an item at a host in response to the identity information in Fig. 20. In this figure, PDA **300**, which is both a host and a client since it is used in a P2P network, provides iconized representations of a VCR with host-commandable features of the VCR represented by icons **311**. In order to provide icons of the VCR to the host, the PDA, the PDA must know what the identity of the VCR is, since Harris' system can be used with many different types of devices. Col. 6 Lines 27-37 discloses, and Fig. 6 shows the P2P devices exchanging information regarding their needs and capabilities "for forming a communication network". Fig. 21 shows addresses being exchanged between two items. Harris discloses in Col. 18 Lines 40-67 that "Controller **300** includes [...] display **309** showing icons **311** corresponding to available commands. Cursor **312** indicates which of icons **311** is selected, with display **307** providing a textual description or identification." Although icons **311** represent VCR tapes that can have actions performed on them from the PDA host, it is understood that the icons could be

representations of the features of any of the other devices that Harris shows in Fig. 3 can be used in his invention.

Re Claims 18-19,

Col. 20 Lines 48-65 of Harris states that the user interface has memory for database capabilities including storage and retrieval of data, which can be located locally on the user's device or remotely on another peer device. Col. 19 Lines 49-67 and Col. 20 Lines 1-20 state that Harris creates a queue of outstanding commands and tracks whether they have yet been processed. Col. 19 Lines 1-10 state that after sending commands to a controlled device, the user's device receives feedback as to whether the commands were accepted. A discontinued interaction in Harris' system could be interpreted as outstanding commands existing after terminating a session (Fig. 25, Finished controlling/commanding?), or outstanding commands after feedback indicates they were that is admittedly capable of saving and retrieving data, to allow outstanding commands to span more than one user session, for the purpose of saving the user time and frustration of having to re-enter commands if, for example, command feedback indicated that a command was not accepted because the device was out of range, and it needed to be re-tried at a later time.

Re Claim 20,

Figs. 8-9 show that one device can need personal information, such as the owner's name, security settings, or a financial transaction, from the other device.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN J. HYLINSKI whose telephone number is (571)270-1995. The examiner can normally be reached on Mon-Fri 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John M. Hotaling, III. can be reached on (571)272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/
Primary Examiner, Art Unit 3714

/STEVEN J HYLINSKI/
Examiner, Art Unit 3714